



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

CLARK & ELBING LLP  
101 FEDERAL STREET  
BOSTON MA 02110

**MAILED**  
**FEB 11 2011**  
**OFFICE OF PETITIONS**

In re Application of :  
Gardella et al. : DECISION ON APPLICATION  
Application Number: 10/564,744 : FOR PATENT TERM ADJUSTMENT  
Filing Date: 03/03/2006 :  
Attorney Docket Number: :  
00786/540002 :

This letter is in response to the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT," filed on October 8, 2010, which is treated as a petition under 37 CFR 1.705(b). Applicants request that the initial determination of patent term adjustment under 35 U.S.C. § 154(b) be increased by 104 days from 259 days to 363 days.

The application for patent term adjustment is **GRANTED** to the extent indicated.

The Office has updated the PALM and PAIR screens to reflect that the revised Patent Term Adjustment determination at the time of the mailing of the Notice of Allowance is three hundred forty-nine (349) days. A copy of the updated PAIR screen, showing the revised determination, is enclosed.

On July 13, 2010, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. §154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 259 days (451 days of Office delay reduced by 192 days of applicant delay). The subject application for patent term adjustment was timely filed on October 8, 2010.<sup>1</sup>

---

<sup>1</sup> PALM records show that the Issue Fee was received on October 8, 2010.

Applicants dispute the reductions of 14 and 92 days, respectively, for the filing of supplemental responses, (in this case, Information Disclosure Statements (IDSs)) on July 20, 2009, 14 days after the filing of a reply on July 6, 2009, and on June 22, 2010, 92 days after the filing of a reply on March 24, 2010.

Applicants assert that the IDSs are accompanied by the statement in accordance with 37 CFR 1.704(d) and, therefore, should not be considered failures to engage in reasonable efforts to conclude processing or examination. Further, the present petition is accompanied by a statement under 37 CFR 1.704(d).

37 CFR 1.704(c)(8) states:

Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping: Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed.

37 CFR 1.704(d) states:

A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

A review of the record reveals that on July 20, 2009, an IDS was filed, 14 days after the day after the date a reply was filed, July 6, 2009, in response to an Office action. The IDS was not accompanied by the statement set forth at 37 CFR 1.704(d).

Applicants' argument that the 14 day period of reduction for applicant delay should be removed is unavailing. It is undisputed that the IDS was not accompanied by the statement set forth under § 1.704(d). Further, there is no provision in the rules for the Office to accept a statement under § 1.704(d) which did not accompany (i.e., was not filed contemporaneously with) the IDS. Accordingly, the reduction of 14 days is proper and will not be removed.

With regard to the supplemental IDS filed on June 22, 2010, a review of the record reveals that a statement in accordance with § 1.704(d) has been provided in the transmittal letter accompanying the IDS. Accordingly, the period of reduction of 92 days is not warranted and will be removed.

Applicants further disclose that a period of two (2) days of reduction for applicant delay should be entered for the filing of a supplemental response on March 24, 2010, two (2) days after the filing of a reply on March 22, 2010.

Upon review, applicants' argument is well taken. On March 22, 2010, a reply to an Office action was filed. On March 24, 2010, a supplemental reply in the form of an IDS was filed, two (2) days after a reply was filed. The IDS was not accompanied by the statement set forth in § 1.704(d). Accordingly a two (2) day reduction for applicant delay is warranted pursuant to 37 CFR 1.704(c)(8).

In view thereof, the determination of PTA at the time of the mailing of the Notice of Allowance is updated to 349 days (451 days of PTO delay, reduced by 102 days (61 + 14 + 25 + 2) days of Applicant delay).

The Office thanks applicants for their good faith and candor in bringing this to the attention of the Office.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Office of Data Management for issuance of a patent. The patent term adjustment

indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3231.



Douglas I. Wood  
Senior Petitions Attorney  
Office of Petitions

Encl: Revised PAIR Calculation

**Patent Term Adjustments**

Patent Term Adjustment (PTA) for Application Number: 10/564,744

|                        |            |  |     |
|------------------------|------------|--|-----|
| Filing or 371(c) Date: | 03-03-2006 | Overlapping Days Between {A and B} or {A and C}: | 0   |
| Issue Date of Patent:  | -          | Non-Overlapping USPTO Delays:                    | 451 |
| A Delays:              | 451        | PTO Manual Adjustments:                          | 90  |
| B Delays:              | 0          | Applicant Delays:                                | 192 |
| C Delays:              | 0          | Total PTA Adjustments:                           | 349 |

**Patent Term Adjustment History****Explanation Of Calculations**

| Number | Date       | Contents Description                            | PTO(Days) | APPL<br>(Days) | Start |
|--------|------------|---|-----------|----------------|-------|
| 99     | 02-09-2011 | Adjustment of PTA Calculation by PTO            |           | 2              | 0     |
| 98     | 02-09-2011 | Adjustment of PTA Calculation by PTO            | 92        |                | 0     |
| 72     | 07-13-2010 | Mail Notice of Allowance                        |           |                | 0     |
| 71     | 07-06-2010 | Issue Revision Completed                        |           |                | 0     |
| 70     | 07-06-2010 | Document Verification                           |           |                | 0     |
| 69     | 07-06-2010 | Notice of Allowance Data Verification Completed |           |                | 0     |
| 68     | 07-06-2010 | Examiner's Amendment Communication              |           |                | 0     |
| 67     | 07-06-2010 | Notice of Allowability                          |           |                | 0     |
| 63     | 06-22-2010 | Information Disclosure Statement considered     |           |                | 0     |
| 62     | 03-24-2010 | Information Disclosure Statement considered     |           |                | 0     |
| 61     | 06-22-2010 | Information Disclosure Statement (IDS) Filed    |           | 92             | 56    |
| 60     | 06-22-2010 | Information Disclosure Statement (IDS) Filed    |           |                | 0     |
| 59     | 03-24-2010 | Reference capture on IDS                        |           |                | 0     |
| 58     | 03-24-2010 | Information Disclosure Statement (IDS) Filed    |           |                | 0     |
| 57     | 04-13-2010 | Date Forwarded to Examiner                      |           |                | 0     |
| 56     | 03-22-2010 | Response after Non-Final Action                 |           | 25             | 51    |
| 55     | 03-22-2010 | Request for Extension of Time - Granted         |           |                | 0     |
| 54     | 03-24-2010 | Information Disclosure Statement (IDS) Filed    |           |                | 0     |
| 53     | 11-25-2009 | Electronic Review                               |           |                | 0     |
| 52     | 11-25-2009 | Email Notification                              |           |                | 0     |
| 51     | 11-25-2009 | Mail Non-Final Rejection                        | 19        |                | 43    |
| 50     | 11-23-2009 | Non-Final Rejection                             |           |                | 0     |
| 49     | 07-06-2009 | Information Disclosure Statement considered     |           |                | 0     |
| 48     | 07-20-2009 | Information Disclosure Statement considered     |           |                | 0     |
| 47     | 07-20-2009 | Information Disclosure Statement (IDS) Filed    |           | 14             | 43    |
| 46     | 07-06-2009 | Reference capture on IDS                        |           |                | 0     |
| 45     | 07-06-2009 | Information Disclosure Statement (IDS) Filed    |           |                | 0     |
| 44     | 09-10-2009 | Date Forwarded to Examiner                      |           |                | 0     |
| 43     | 07-06-2009 | Response after Non-Final Action                 |           | 61             | 36    |
| 42     | 07-06-2009 | Request for Extension of Time - Granted         |           |                | 0     |
| 41     | 07-20-2009 | Information Disclosure Statement (IDS) Filed    |           |                | 0     |
| 40     | 07-06-2009 | Information Disclosure Statement (IDS) Filed    |           |                | 0     |
| 38     | 02-06-2009 | Electronic Review                               |           |                | 0     |
| 37     | 02-06-2009 | Email Notification                              |           |                | 0     |
| 36     | 02-06-2009 | Mail Non-Final Rejection                        | 13        |                | 32    |
| 35     | 02-02-2009 | Non-Final Rejection                             |           |                | 0     |
| 34     | 11-29-2007 | Information Disclosure Statement considered     |           |                | 0     |
| 33     | 10-29-2008 | Date Forwarded to Examiner                      |           |                | 0     |
| 32     | 09-24-2008 | Response to Election / Restriction Filed        |           |                | 0     |
| 31     | 09-24-2008 | Request for Extension of Time - Granted         |           |                | 0     |
| 29     | 08-15-2008 | Mail Post Card                                  |           |                | 0     |

|    |            |   |     |   |
|----|------------|---|-----|---|
| 28 | 08-07-2008 | Email Notification                                      |     | 0 |
| 27 | 07-21-2008 | Mail Supplemental Restriction / Election Requirement    |     | 0 |
| 26 | 07-17-2008 | Supplemental Restriction                                |     | 0 |
| 25 | 06-26-2008 | Electronic Review                                       |     | 0 |
| 24 | 06-25-2008 | Email Notification                                      |     | 0 |
| 23 | 06-25-2008 | Mail Restriction Requirement                            | 419 | 9 |
| 22 | 06-23-2008 | Requirement for Restriction / Election                  |     | 0 |
| 20 | 04-15-2008 | Email Notification                                      |     | 0 |
| 19 | 04-15-2008 | Change in Power of Attorney (May Include Associate POA) |     | 0 |
| 18 | 04-09-2008 | Correspondence Address Change                           |     | 0 |
| 17 | 11-29-2007 | Reference capture on IDS                                |     | 0 |
| 16 | 11-29-2007 | Information Disclosure Statement (IDS) Filed            |     | 0 |
| 15 | 11-29-2007 | Information Disclosure Statement (IDS) Filed            |     | 0 |
| 14 | 11-06-2007 | Case Docketed to Examiner in GAU                        |     | 0 |
| 13 | 10-29-2007 | IFW TSS Processing by Tech Center Complete              |     | 0 |
| 11 | 08-30-2007 | PG-Pub Issue Notification                               |     | 0 |
| 10 | 06-05-2007 | Application Dispatched from OIPE                        |     | 0 |
| 9  | 03-03-2006 | 371 Completion Date                                     |     | 0 |
| 8  | 05-17-2007 | Sent to Classification Contractor                       |     | 0 |
| 7  | 05-17-2007 | Notice of DO/EO Acceptance Mailed                       |     | 0 |
| 6  | 10-31-2006 | CRF Is Good Technically / Entered into Database         |     | 0 |
| 5  | 04-20-2006 | Preliminary Amendment                                   |     | 0 |

---

[Close Window](#)